

REMARKS

I. Claim Rejections Under 35 USC § 112

A. Claim 4 was rejected for insufficient antecedent basis regarding the limitation “said first rectangular block.” Claim 4 has been amended to depend on claim 2, which provides proper antecedent basis for the limitation “said first rectangular block.”

B. Claim 8 (line 5) has been amended to read --troughs on said second crimping block--.

C. Claim 13 has been amended to depend on claim 9.

III. Claim Rejection Under 35 USC § 102

Examiner rejects claims 1-3, 5, 9 and 14 under 35 U.S.C. § 102 as being anticipated by United States Patent No. 4,60,379 to Jaskolski (hereinafter “‘379 patent” or “Jaskolski”).

A claim is anticipated only if “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully traverses the § 102(b) rejections based upon the ‘379 patent because

Jaskolski does not expressly or inherently teach each and every element of Applicant's claimed invention.

Previously in the Response to the Office Action of February 9, 2006, Applicant had argued that the "set screws" in Jaskolski are not the same as the crimping "ribs" of the present invention because the screws are a distinct movable element in the pin machining fixture, whereas the ribs are "integral" to the body of the first crimping block. (Further, the ribs have a clear functional limitation recited in the claim, "for engaging a connector fitted on the end of a cable," which is distinguishable over the function of the set screws in Jaskolski.) Accordingly, Applicant previously amended claim 1 to more clearly define the structure of the ribs by adding the limitation that said ribs are "integral" to the first crimping block.

However, Examiner has remarked that the ribs are "deemed integral to the first crimping block," citing In re Hotte, 177 USPQ (CCPA 1973), since "[i]t has been held that 'integral' is sufficiently broad to embrace constructions united by such means as fastening and welding." See 7/10/06 Office Action at p. 4. Examiner noted that the "set screws are fastened within holes into the block and do not move of their own accord." See *id.*

Applicant submits that, because the set screws in Jaskolski are movable and removable, the screws cannot be understood as being "integral" to the block under In re Hotte. As noted by Examiner, Hotte remarks that 'integral' can encompass

“such means as fastening and welding,” both terms suggestive of permanent affixture. Nonetheless, Applicant has further amended claim 1 to distinguish over Jaskolski as discussed below.

Specifically, Applicant has amended claim 1 to read: “...said plurality of crimping ribs ~~integral to~~ formed of said first crimping block...”. As amended, claim 1 is not anticipated by the ‘379 patent because, in Jaskolski, the screws are separate components that cannot be said to be “formed of” the block. Applicant submits that this amendment makes clear that the ribs are “formed of” the block in the sense that they are of one piece with the block (such as to be not movable and not removable). By contrast, in the ‘379 patent it is disclosed that the set screws are movable and removable by being “threaded through top 18.” *See* ‘379 patent at Col. 2, lines 36-37. Therefore, claim 1 is not anticipated because Jaskolski does not disclose permanent ribs “formed of” the block body.

Furthermore, it is noted that Examiner did not reject claim 7 under § 102, which recites: “crimping troughs on said second crimping block vary in size to accommodate different size cables.” Applicant has further amended claim 1 by incorporating the limitation of claim 7 as follows:

1. A crimping device for crimping connectors on variable sized cables comprising:
 - a first crimping block having a plurality of crimping ribs for engaging a connector fitted on the end of a cable, said plurality of

crimping ribs integral to formed of said first crimping block and having a length the same as the width of said first crimping block;

a second crimping block having a plurality of crimping troughs on a surface adapted to mate with said ribs on said first crimping block, said plurality of crimping troughs on said second crimping block vary in size to accommodate different size cables;

Since independent claim 1 is not anticipated, dependent claims 2-3, 5, 9 and 14 are likewise not anticipated.

III. Claim Rejection Under 35 USC § 103

A. Claims 1-3, 5, 9, and 14 Not Obvious Over Jaskolski

Examiner rejects claims 1-3, 5, 9, and 14 (in the alternative) as being obvious over Jaskolski. Examiner remarks that, “[t]he extent applicant disagrees that the set screws are an integral part of the block, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893). Examiner notes that, “[i]n the cited case, a stove grate, which had formerly been cast in two pieces and put together, is cast in one piece. The court found that this does not constitute novelty or invention.” *See* 7/10/06 Office Action at p. 4.

Claim 1 is not obvious over Jaskolski. It is not merely that the ribs are different from the screws in that they are integral to and formed of the block, but—importantly—the ribs have a completely different functional purpose than the

screws in Jaskolski. The ribs have the clear functional purpose of crimping, as set forth in the claim language: “for engaging a connector fitted on the end of a cable” and “a respective crimping rib engages a respective crimping trough crushing and securely crimping said connector on an end of said cable.” Given the functional purpose of the ribs, claim 1 has been amended to describe the structure of the ribs as: “said plurality of crimping ribs ~~integral to~~ formed of said first crimping block and having a width the same as that of said first crimping block”. The width of the ribs being the same as the crimping block is important because, as such, it provides greater surface area for crimping than the set screws in Jaskolski. The structural and functional limitations as set forth in claim 1 clearly render the ribs nonobvious over the set screws of Jaskolski.

In sum, Applicant submits that it would not have been obvious from Jaskolski to form the crimping device of the present invention, especially when the underlying “nature of the problem to be solved” is considered. *See* MPEP § 2143.01.

B. Law on Obviousness

Section 2142 of the Manual of Patent Examining Procedure (MPEP) provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,

to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *See* MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, *and the nature of the problem to be solved as a whole* would have suggested to those of ordinary skill in the art." *See id.*, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (emphasis added); *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." (emphasis in original).

C. Claims 1-5 are Non-obvious Over Swage-It in View of Newell

Examiner rejects claims 1–5, 14 and 15 as being obvious over Swage-It in view of United States Patent No. 4,322,123 to Newell (hereinafter “Newell”).

Claims 1-5 are non-obvious over Swage-It in view of Newell because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings as suggested by Examiner.

It is important to recognize that Swage-It (as the name implies) is “a tool used by metalworkers for shaping their work by *holding* it on the work or the work on it and striking with a hammer or sledge.” *See* Merriam-Webster Online Dictionary (emphasis added). As shown in the Swage-It reference and as recognized by Examiner, “Swage does not disclose ... a plurality of crimping ribs.” *See* 7/10/06 Office Action at p. 7. With the Swage-It tool, the respective troughs interact with each other (not with opposing ribs) to hold cables.¹ There is

¹ As such, Swage-It is not unlike USP 1,451,727 to Harburg, which was previously cited by Examiner. Harburg teaches a “pipe holding device,” that “has for its object to provide a device of this character comprising a registering and engaging bars detachably connected together, the engaging faces of said bars being provided with spaced transversely disposed *semi-circular grooves for the reception of various sizes of pipes...*” *See* Harburg at Col. 1, lines 11-22 (emphasis added). The bolts in Harburg function to hold the clamping blocks together. The Harburg bolts do not function to actuate the crimping process. With Harburg, as with Swage-It, the tools have no crimping ability.

no crimping involved.² Whereas in claim 1, on the other hand, it is recited that the bolts are tightened down “until a respective crimping rib engages a respective crimping trough crushing and securely crimping said connector on an end of said cable.” See claim 1.

Examiner asserts that Newell teaches “a crimping device,”³ and asserts that “it would have been obvious ... to modify the crimping blocks of Swage, in view of the teachings of Newell, *by replacing the troughs of the first block with a plurality of ribs as described above*, so that a more secure fit can be effected between a terminal and a cable, than can be produced by having crimping troughs on both blocks. See abstract of US4043174 for further supportive evidence.” See 7/10/06 Office Action at p. 8 (emphasis added).

² Examiner states that “the first block of Swage has crimping troughs.” See 7/10/06 Office Action at p. 7. However, since there are no ribs acting directly on the troughs, the troughs cannot function in a crimping manner. The tool is for swaging.

³ Newell does not teach a crimping device having either a “first crimping block” or a “second crimping block.” The crimping device of Newell, resembling an office stapler, has “arm portions 40 and 42 which are *integrally joined* at 44.” See Newell at Col. 3, line 18 (emphasis added). More specifically, in Newell, item 48 in Fig. 2 is a “gripping surface.” See Newell at Col. 3, line 18. Item 48 is not is a “first crimping block,” as asserted by Examiner. Similarly, item 52 in Newell is not a “second crimping block,” but rather another “outwardly directed gripping surface.” See Newell at Col. 3, lines 24-25. As such, Newell teaches only a crimping tool having two arms, with a singular “crimping tooth 46” on one arm and a complementary “recessed area 50” on the other arm. See Newell at Col. 3, lines 20-22.

However, there is absolutely no teaching, in either Swage-It or Newell (or in the abstract of the '174 patent), to combine the references “by replacing the troughs of the first block with a plurality of ribs,” as suggested by Examiner. Moreover, Applicant submits that, given the nature of the problems to be solved by Swage-It (*i.e.* to provide a swaging tool) and Newell (a single crimping tool), there is no motivation to combine the two disparate and different references.

Further still, claim 1 has been amended to include the limitation that the “said plurality of crimping troughs on said second crimping block vary in size to accommodate different size cables”. Neither Swage-It nor Newell teaches this aspect of the invention.

Since no express teaching can be found in Swage-It and Newell to combine the references and given that the nature of the problems to be solved are different, the MPEP requires that the Examiner provide an objective source to support a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination “would have been obvious to one skilled in the art” is improper if made without support. *In re Garrett*, 33 BNA PTCJ 43 (November 13, 1986).

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings

of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)... [See also] *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

The mere fact that references could be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, which in this case they do not. Claim 1 is thus non-obvious over Swage-It in view of Newell. Therefore, claims 2-5, 14 and 15 are non-obvious as well.

D. Claims 6-8 are Non-obvious Over Swage-It and Newell in View of Wilson

Examiner rejects claims 6-8 as being obvious over Swage-It and Newell, as applied to claim 1 above, in view of United States Patent No. 3,172,454 to Wilson (“Wilson”). Examiner asserts that Wilson teaches a second block “with troughs on two opposite faces of the block, the troughs being of various sizes, so as to double the number of troughs...”. *See* 7/10/06 Office Action at p. 8. Therefore, it is concluded by Examiner that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the second crimping block of Swage and Newell, in view of the teachings of Wilson, by providing the second crimping block with all the structural limitations of claims 6-8, so as to allow the

crimping device to engage twice as many different sizes of cables.” *See* 7/10/06 Office Action at p. 9.

Claim 6 is dependent from claim 1. Claim 7 has been canceled. And claim 8 has been amended to depend from claim 6. Since claim 1 is not obvious over Swage-It and Newell for the reasons discussed above, the dependent claims are not obvious as well, regardless of Wilson.

E. Claim 9 is Non-obvious Over Swage-It and Newell in View of Dobrosielski

Examiner rejects claim 9 as being obvious over Swage-It and Newell, as applied to claim 1 above, in view of United States Patent No. 3,018,127 to Dobrosielski *et al.* (“Dobrosielski”). *See* 7/10/06 Office Action at p. 10. Because claim 9 depends from claim 1, and claim 1 is not obvious over Swage-It in view of Newell for the reasons discussed above, claim 9 is not obvious as well, regardless of Dobrosielski.

F. Claims 10 and 12 are Non-obvious Over Swage-It and Newell in View of Hamilton

Examiner rejects claims 10 and 12 as being obvious over Swage-It and Newell, as applied to claim 1 above, in view of United States Patent No. 4,192,171 to Hamilton (“Hamilton”). *See* 7/10/06 Office Action at p. 11. Claim 10 depends from claim 1 and, in turn, claim 12 depends from claim 10. Since claim 1 is not

obvious over Swage-It in view of Newell for the reasons discussed above, claims 10 and 12 are not obvious as well, regardless of Hamilton.

G. Claim 13 is Non-obvious Over Swage-It, Newell, and Hamilton in View of Echols

Examiner rejects claim 13 as being obvious over Swage-It, Newell, and Hamilton, as applied to claim 10 above, in view of United States Patent No.1,425,757 to Echols (“Echols”). *See* 7/10/06 Office Action at p. 11. However, claim 13 has been amended to depend from claim 9, which, in turn, depends from claim 1. Since claim 1 is not obvious over Swage-It in view of Newell for the reasons discussed above, claim 9 and thus claim 13 are not obvious as well, regardless of Echols.

CONCLUSION

The Examiner is respectfully requested to reconsider the objections and rejections of the claims in view of the remarks made herein. It is believed that this application—particularly, claims 1-15—has been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

If any additional fees are required as a result of this amendment, or any credit needs to be made for overpayment of fees, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 500703.

Respectfully submitted,

TROJAN LAW OFFICES

By

/s/ R. Joseph Trojan

Sept. 13, 2006

R. Joseph Trojan

Reg. No. 34,264

RJT:dcd
TROJAN LAW OFFICES
9250 Wilshire Blvd., Suite 325
Beverly Hills, CA 90212
Telephone: (310) 777-8399